



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,376	10/24/2005	Andreas Dietz	10537/289	3384
26646 7590 10/15/2008 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
LEADER, WILLIAM T				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
10/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,376

Applicant(s)

DIETZ ET AL.

Examiner

WILLIAM T. LEADER

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Receipt of the papers filed on June 10, 2008. Claims 1-8 and 16-22 are canceled. Claims 9-15 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Claims 9, 12, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by German patent publication DE 37 16935 A1 to Thoma.
4. The Thoma '935 publication is directed to the production of a corrosion protection layer by galvanic (electrolytic) dispersion coating. As shown in the English language machine translation of claim 1, the process includes the steps of electrolytic deposition of nickel or cobalt in a deposition bath in which particles including titanium, but not including chromium, are suspended, the particles becoming dispersed in the coating, and heat treating the coated substrate. All limitations recited in instant claim 9 are taught by Thoma '935. With respect to claims 12 and 13 the particles used by Thoma contain silicon, and the silicon is alloyed with titanium. With respect to instant claim 14, Thoma '935 recites

particles of a size preferably in the range of 1 to 5 μm (claim 3). This range falls within the range of 1-50 μm recited by applicant. In the operative example, Thoma discloses the use of a grain size within a preferred range of 2 to 5 μm . Particles of this size fall within the range recited by applicant and anticipate applicant's claim. See MPEP 2131.03.

Claim Rejections - 35 USC § 103

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over German patent publication DE 37 16935 A1 to Thoma.
6. Claim 15 recites a coating thickness of 10 to 100 μm . Thoma '935 recites a coating thickness between 10 and 1000 μm (claim 6). Choice of a value from within the range disclosed by Thoma '935 would have been *prima facie* obvious because Thoma shows values within the range to be useful. See MPEP 2144.05.
7. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over German patent publication DE 37 16935 A1 to Thoma in view of Thoma et al (US 4,895,625).
8. As indicated in the previous office action, the Thoma et al patent '625 is directed to electrolytically depositing a protective coating on structural components such as gas turbine blades. See the abstract. The process includes the step of

electrodeposition of Ni in a deposition bath in which particles including Al with no Cr are suspended. The particles become occluded in the coating. See column 2, lines 44-54. The coated substrate is heat treated whereby the heat treatment causes alloying. See column 2, lines 54-58. Thoma discloses that the type of powder mixture included in the electrolytic bath depends on the particular requirements that must be met by the coating (column 3, lines 55-62). Thoma discloses a number of alloys that are useful (column 3, lines 63-65). Constituents of these alloys include Ni, Co and Si. It would have been obvious to have included Ni or Co as an alloying constituent of the particles in the process of Thoma '935 because these elements are known to be useful in forming a corrosion resistant coating as shown by Thoma et al '625.

9. Claim 10 recites that the particles include an oxide layer. Thoma et al '625 disclose the step of passivating the particle surfaces. The passivation contributes to uniform film or layer structure. See column 3, lines 37-50. It would have been obvious to have performed a step of forming an oxide layer to passivate the particles in the process of Thoma '035 because the structure of the deposited layer would have been improved as taught by Thoma et al '625.

Response to Arguments

10. Applicant's arguments with respect to claims 9-15 as amended have been considered but are moot in view of the new ground(s) of rejection. Applicant argues that the claims as amended recite particles including at least one of (a) Mg, (b) Ti and (d) Zn, and not including Cr. For the reasons given above, this claim limitation, along with all other claim limitations are taught by the prior art as now applied.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. EP 0 316 388 B1 is from the same patent family as DE 37 16935 A1 applied above. The English language claims are more idiomatic than the machine translation of the claims in the DE 37 16935 patent publication.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM T. LEADER whose telephone number is (571) 272-1245. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Susy Tsang-Foster can be reached on 571-272-1293. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Leader/
October 7, 2008
/SUSY N TSANG-FOSTER/
Supervisory Patent Examiner, Art Unit 1795